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**SEP 30 2009**

**OFFICE OF PETITIONS**

In re Application of  
Plantenga, et al.  
Application No. 10/728,489  
Filed: December 5, 2003  
Attorney Docket No. ACH2976 US

ON PETITION

This is a decision on the petition under 37 CFR 1.137(a), filed September 11, 2009, to revive the above-identified application.

The petition under 37 CFR 1.137(a) is **DISMISSED**.

The above-identified application became abandoned for failure to reply to the final Office action mailed January 10, 2008, which set a shortened statutory period for reply of three (3) months from its mailing date. No response was received within the allowable period, and the application became abandoned on April 11, 2008. A Notice of Abandonment was mailed on August 22, 2008.

A grantable petition under 37 CFR 1.137(a)<sup>1</sup> must be accompanied by: (1) the required reply,<sup>2</sup> unless previously filed; (2) the petition fee as set forth in 37 CFR 1.17(1); (3) a showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unavoidable; and (4) any terminal disclaimer required by 37 CFR 1.137(c).

The instant petition lacks item (3).

**The Commissioner is responsible for determining the standard for unavoidable delay and for applying that standard.**

“In the specialized field of patent law, . . . the Commissioner of Patent and Trademarks is

<sup>1</sup> As amended effective December 1, 1997. See Changes to Patent Practice and Procedure; Final Rule Notice 62 Fed. Reg. 53131, 53194-95 (October 10, 1997), 1203 Off. Gaz. Pat. Office 63, 119-20 (October 21, 1997).

<sup>2</sup> In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof.

primarily responsible for the application and enforcement of the various narrow and technical statutory and regulatory provisions. The Commissioner's interpretation of those provisions is entitled to considerable deference."<sup>3</sup>

"[T]he Commissioner's discretion cannot remain wholly uncontrolled, if the facts **clearly** demonstrate that the applicant's delay in prosecuting the application was unavoidable, and that the Commissioner's adverse determination lacked **any** basis in reason or common sense."<sup>4</sup>

"The court's review of a Commissioner's decision is 'limited, however, to a determination of whether the agency finding was arbitrary, capricious, an abuse of discretion, or otherwise not in accordance with the law.'"<sup>5</sup>

"The scope of review under the arbitrary and capricious standard is narrow and a court is not to substitute its judgment for that of the agency."<sup>6</sup>

#### **The standard**

"[T]he question of whether an applicant's delay in prosecuting an application was unavoidable must be decided on a case-by-case basis, taking all of the facts and circumstances into account."<sup>7</sup>

The general question asked by the Office is: "Did petitioner act as a reasonable and prudent person in relation to his most important business?"<sup>8</sup> Nonawareness of a PTO rule will not constitute unavoidable delay.<sup>9</sup>

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<sup>3</sup>Rydeen v. Quigg, 748 F.Supp. 900, 904, 16 U.S.P.Q.2d (BNA) 1876 (D.D.C. 1990), aff'd without opinion (Rule 36), 937 F.2d 623 (Fed. Cir.1991) (citing Morganroth v. Quigg, 885 F.2d 843, 848, 12 U.S.P.Q.2d (BNA) 1125 (Fed. Cir. 1989); Ethicon, Inc. v. Quigg 849 F.2d 1422, 7 U.S.P.Q.2d (BNA) 1152 (Fed. Cir. 1988) ("an agency' interpretation of a statute it administers is entitled to deference"); see also Chevron U.S.A. Inc. v. Natural Resources Defence Council, Inc., 467 U.S. 837, 844, 81 L. Ed. 694, 104 S. Ct. 2778 (1984) ("if the statute is silent or ambiguous with respect to the specific issue, the question for the court is whether the agency's answer is based on a permissible construction of the statute."))

<sup>4</sup>Commissariat A L'Energie Atomique et al. v. Watson, 274 F.2d 594, 597, 124 U.S.P.Q. (BNA) 126 (D.C. Cir. 1960) (emphasis added).

<sup>5</sup>Haines v. Quigg, 673 F. Supp. 314, 316, 5 U.S.P.Q.2d (BNA) 1130 (N.D. Ind. 1987) (citing Camp v. Pitts, 411 U.S. 138, 93 S. Ct.1241, 1244 (1973) (citing 5 U.S.C. §706 (2)(A)); Beerly v. Dept. of Treasury, 768 F.2d 942, 945 (7th Cir. 1985); Smith v. Mossinghoff, 217 U.S. App. D.C. 27, 671 F.2d 533, 538 (D.C. Cir.1982)).

<sup>6</sup>Ray v. Lehman, 55 F.3d 606, 608, 34 U.S.P.Q.2d (BNA) 1786 (Fed. Cir. 1995) (citing Motor Vehicles Mfrs. Ass'n v. State Farm Mut. Auto. Ins. Co., 463 U.S. 29, 43, 77 L.Ed.2d 443, 103 S. Ct. 2856 (1983)).

<sup>7</sup>Id.

<sup>8</sup>See In re Mattulah, 38 App. D.C. 497 (D.C. Cir. 1912).

<sup>9</sup>See Smith v. Mossinghoff, 671 F.2d 533, 538, 213 U.S.P.Q. (BNA) 977 (Fed. Cir. 1982) (citing Potter v. Dann, 201 U.S.P.Q. (BNA) 574 (D.D.C. 1978) for the proposition that counsel's nonawareness of PTO rules does not constitute "unavoidable" delay)). Although court decisions have only addressed the issue of lack of knowledge of an attorney, there is no reason to expect a

### **Application of the standard to the current facts and circumstances**

In the instant petition, petitioner maintains that the circumstances leading to the abandonment of the application meet the aforementioned unavoidable standard and, therefore, petitioner qualifies for relief under 37 CFR 1.137(a). In support thereof, petitioner asserts the Advisory Action, informing petitioner that the response filed May 8, 2008, was not sufficient to place the application in condition for allowance, was not received at the address of record because the USPTO did not enter the request to change the correspondence address that was previously filed.

With regard to item (3), a review of the record reveals that Change of Correspondence Address was filed April 17, 2007, and was signed by Michael Bell. A review of the application filed history reveals that two other requests to change the correspondence address were filed on January 5, 2007, and March 28, 2007. None of the requests were entered because the person who signed the request was not an attorney of record for the customer number and, therefore, not authorized to make such a request. Accordingly, the USPTO continued to mail the correspondence to the address as cited in the application file. In order to successfully assert unavoidable delay in such a circumstance, petitioner must establish that a proper request to change the correspondence address was promptly filed prior to the date the communication was mailed. The instant petition does not accomplish this.

It is further noted the Advisory Action was not received at the correspondence address that should have been of record.. It is noted, however, that the mailing of an Advisory Action is not a requirement of the USPTO. It is incumbent upon petitioner to be sure that a proper and timely response to any Office action is received. Because petitioner received the final Office action, petitioner was responsible for ensuring that a timely and proper reply was filed thereafter. Accordingly, failure to receive the Advisory Action cannot be considered a cause for unavoidable delay in providing a timely and proper response to the final Office action.

It is also noted that the application became abandoned on April 11, 2008, and a Notice of Abandonment was mailed on August 22, 2008, yet the petition was not filed until more than a year later. Petitioner is required to establish that the entire delay—from the due date for the reply until the filing of a grantable petition was unavoidable. Accordingly, petitioner must explain when petitioner discovered the application was abandoned and how the entire period during which the application was abandoned was unavoidable.

Alternatively, petitioner may revive the application based on unintentional abandonment under 37 CFR 1.137(b). A grantable petition pursuant to 37 CFR 1.137(b) must be accompanied by the required reply, the required petition fee (\$1,620.00 for a large entity and \$810.00 for a verified small entity), and a statement that the **entire** delay in filing the required

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different result due to lack of knowledge on the part of a pro se (one who prosecutes on his own) applicant. It would be inequitable for a court to determine that a client who spends his hard earned money on an attorney who happens not to know a specific rule should be held to a higher standard than a pro se applicant who makes (or is forced to make) the decision to file the application without the assistance of counsel.

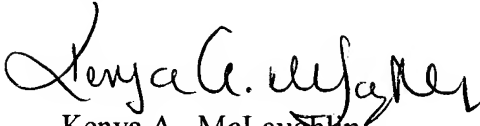
reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Commissioner for Patents  
United States Patent and Trademark Office  
Box 1450  
Alexandria, VA 22313-1450

By facsimile: (571) 273-8300  
Attn: Office of Petitions

Telephone inquiries regarding this decision should be directed to the undersigned (571) 272-3222.

A handwritten signature in cursive script, appearing to read "Kenya A. McLaughlin".

Kenya A. McLaughlin  
Petitions Attorney  
Office of Petitions